

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Sandro Pasquali

Application No.: 09/859,528

Confirmation No.: 8092

Filed: March 19, 2001

Art Unit: 3622

For: **SYSTEM AND METHOD FOR PROVIDING A
DYNAMIC ADVERTISING CONTENT
WINDOW WITHIN A WINDOWS BASED
CONTENT MANIFESTATION
ENVIRONMENT PROVIDED IN A BROWSER**

Examiner: A. D. Duran

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.37(a), this brief is filed after the Notice of Decision from Pre-Appeal Brief Review was mailed July 12, 2007 in this case and is in furtherance of the Notice of Appeal file April 4, 2007.

The fees required under § 41.20(b)(2) are dealt with in the accompanying
TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1205.2.

TABLE OF CONTENTS

I. REAL PARTY IN INTEREST	1
--	----------

II.	RELATED APPEALS AND INTERFERENCES	2
III.	STATUS OF THE CLAIMS	3
IV.	STATUS OF AMENDMENTS	4
V.	SUMMARY OF CLAIMED SUBJECT MATTER.....	5
VI.	GROUND OF REJECTION TO BE REVIEWED ON APPEAL	8
VII.	ARGUMENT.....	9
A.	Rejection of Claim 32 under 35 U.S.C. §112, second paragraph.	9
B.	Rejections Under 35 U.S.C. § 102(e) In View of <i>Gerace</i>	11
1.	Claims 9, 23, 32, 43 and 54	11
i.	Claim 9.....	13
ii.	Claim 23.....	14
iii.	Claim 32.....	15
iv.	Claim 43.....	16
v.	Claim 54.....	17
2.	Dependent Claims 10, 24 and 48 are Separately Patentable.....	18
3.	Dependent Claims 11, 25, 38, 49 and 60 are Separately Patentable.....	18
4.	Dependent Claims 34-37, 45-47 and 56-59 are Separately Patentable.....	19
C.	Rejections Under 35 U.S.C. §103(A) As Being Unpatentable Over <i>Gerace</i> In View Of Teachings Known To One Of Ordinary Skill In The Art.....	20
1.	Claims 12 and 26	20
2.	Claims 13, 27-31, 33, 39-42, 44, 50-53, 55, and 61-64	20
i.	Claims 13 and 27	20
ii.	Claims 28, 40, 51 and 62	21
iii.	Claims 29, 39, 50 and 61	21
iv.	Claims 30, 41, 52 and 63	21
v.	Claims 31, 42, 53 and 64	21
vi.	Claims 33, 44 and 55	21
D.	Conclusion	23
VIII.	CLAIMS APPENDIX.....	24
IX.	EVIDENCE APPENDIX.....	30
X.	RELATED PROCEEDINGS APPENDIX.....	31
XI.	COPY OF PRELIMINARY AMENDMENT	32

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Simple.com, Inc. with offices located at 77 Mowat Ave., Suite 414; Toronto, Ontario, Canada M6K 3E3.

II. RELATED APPEALS AND INTERFERENCES

There are no pending appeals or interferences in connection with the instant application. However, patents of Appellant in the general field of technology of the instant application including U.S. Patent No. 6,272,493 referenced at page 9, lines 23-25 and page 14, lines 10-15 of the instant application together with U.S. Patent Nos. 6,434,563 and 6,535,882 claiming priority therefrom are involved in litigation pending in the United States District Court for the Eastern District of New York entitled *Computer Associates International, Inc. v. Simple.Com, Inc., and Wired Solutions, L.L.C.*, Civil File No. 2:02-cv-02748.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 47 claims pending in application.

B. Current Status of Claims

1. Claims canceled: 1-8 and 14-22
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 9 - 13 and 23 - 64
4. Claims allowed: None
5. Claims rejected: 9 - 13 and 23 - 64

C. Claims On Appeal

The claims on appeal are claims 9 - 13 and 23 - 64.

IV. STATUS OF AMENDMENTS

The Amendment After Final Action Under 37 C.F.R. 1.116 filed January 4, 2007 has been refused entry for purposes of appeal as indicated in the Advisory Action of January 25, 2007. However, while the listing of the claims present in that Amendment indicated claim 32 as “Currently Amended”, applicant maintained and herein reasserts that claim 32 was complete as originally presented in the Preliminary Amendment as filed on March 19, 2001 contemporaneously with the filing of the subject continuation application (see Appendix D). Inspection of the Preliminary Amendment on the Patent Application Information Retrieval (PAIR) system confirms that claim 32 was submitted in its entirety by that Preliminary Amendment. No other “amendments” to the claims are pending.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A summary of the claimed subject matter with cross-reference to elements of the preferred embodiments described in the specification is provided below. Such cross-reference is not a representation by applicant that the scope of the claimed subject matter be limited to the preferred embodiments. Parenthetical references are to page and line numbers appearing in the specification unless otherwise indicated to be to designated figures of the drawings and object appearing therein.

According to claim 9 a window object (7: 24) manifested within a windows based content manifestation environment [“CME”] (Fig. 1: 101; 5: 9-14; 8:7-10; 10:4-8) provided within a web browser client (Fig. 1: 101; 5: 9-10), comprises a content manifestation area (Fig. 1: 116; 5:22-25; 10:29-11:2) configured to dynamically manifest advertising content (11:29 – 12:3; Figs. 3A and 3B; 13:24 – 15:1) received from an advertising content source (14:26-28) via an electronic data network (Fig. 2: “Network Connection”; 12: 13-23; Fig. 3B step S3-8; 14: 26-31).

According to claim 23 a controllable window object (8: 7-8) manifested within a content manifestation environment [“CME”] (Fig. 1: 101; 5: 9-14; 8:7-10; 10:4-8) provided within a web browser client (Fig. 1: 101; 5: 9-10; 7:16-19), comprises a content manifestation area (Fig. 1: 116; 5:22-25; 10:29-11:2) configured to dynamically manifest advertising content (11:29 – 12:3; Figs. 3A and 3B; 13:24 – 15:1) received from an advertising content source (Fig. 2: 212-214; 14:26-28) via an electronic data network (Fig. 2: “Network Connection”; 12: 13-23; Fig. 3B step S3-8; 14: 26-31) and a control facility configured to control display attributes associated with said content manifestation area (Fig. 1: 116; 9: 3-8; 10: 23-28).

According to claim 32 a system for providing a dynamic content window (11: 11-13) within a windows based content manifestation environment [“CME”] (Fig. 1: 101; 5: 9-14; 8:7-10; 10:4-8) provided within a web browser (Fig. 1: 101; 5: 9-10) comprises a server system configured to transmit a software system and data related to a content source via an electronic data network (Fig. 2: 210; 11: 29 – 12: 3, 13- 15; Fig. 3: step S3-5); and a web browser client (Fig. 1:101; 5: 9-10; 7: 16 -19) operating within a data processing system (Fig. 2: 206) that is coupled to said server system (Fig. 2: 210) via the electronic data network (Fig. 2: “Network Connection”; 10: 18-22; 13: 4-21) and having a content manifestation environment [“CME”]

(Fig. 1: 101; 5: 9-14; 8:7-10; 10:4-8; 14: 16-18, 26-31) said web browser client operative to receive said software system (Fig. 3A” step S3-5) and said data (13: 10-20), to process said software system and said data to produce a controllable window object (Fig. 1:114; Fig. 3B” step S3-7; 8: 7-8) within said content manifestation environment (Fig. 1: 101) of said web browser client (8: 7-10), said controllable window object (Fig. 1: 114) configured to dynamically manifest therein content received from said content source (Fig. 2: 212-214) in accordance with said data (Fig. 3B: step S3-8; 9: 29 – 10: 3; 13: 24-28; 14: 19-25).

According to claim 43 a method for providing a controllable window object (Fig. 1: 114) within a windows based content manifestation environment (Fig. 1: 101) provided within a web browser, comprises the steps of, from a server system (Fig. 2: 210), transmitting a software system and data related to a content source via an electronic data network (Fig. 3A, step S3-5; 11: 29 – 12: 3, 13- 15); at a web browser client operating within a data processing system (Fig. 2: 212) that is coupled to said server system (Fig. 2: 210) via the electronic data network (Fig. 2: “Network Connection”), receiving said software system (Fig. 3A, step S3-5; 18, 26-31), said web browser client operative to receive said software system and said data (13: 10-20); processing said software system and said data to produce a controllable window object (Fig. 1: 114) within a content manifestation environment (Fig. 1: 101) provided by said web browser (Fig. 3A, step S3-6; Fig. 3B, step S3-7; 8: 7-10); and dynamically manifesting said content within said controllable window object (Fig. 1: 114) in accordance with said data (Fig. 3B, step S3-8; 9: 29-10: 3; 13: 24-28; 14: 19-25).

According to claim 54 a system for providing a dynamic content window within a windows based content manifestation environment provided within a web browser comprises a server system configured to transmit a software system and data related to a content source via an electronic data network (Fig. 2: 210; 11: 29 – 12: 3, 13- 15); and a web browser client operating within a data processing system (Fig. 2: 202) that is coupled to said server system (Fig. 2: 210) via the electronic data network (Fig. 2: “Network Connection”) and having a content manifestation environment, said web browser client (5: 9-10; 7: 16 -19) operative to receive said software system and said data, to process said software system and said data to produce a window object (Fig. 1: 114; 8: 7-8) within said content manifestation environment of said web browser client (Fig. 1: 101; 8: 7-10), said window object (Fig. 1: 114) configured to dynamically

manifest therein content received from said content source in accordance with said data (Fig. 1: 116; 9: 29 – 10: 3; 13: 24-28; 14: 19-25)., said window object (Fig. 1: 114) being under the direct control of the web browser (8: 7-10).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Applicant seeks review of the following grounds of rejection set forth in the Final Office Action having a mailing date of January 8, 2007 (hereinafter the “Office Action”):

Whether claim 32 is properly rejected under 35 U.S.C. §112, second paragraph.

Whether claims 9-11, 23-25, 32, 34-38, 43, 45-49, 54, and 56-60 are properly rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 5,848,396 to Gerace (hereinafter *Gerace*).

Whether claims 12, 13, 26-31, 33, 39-42, 44, 50-53, 55, and 61-64 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over *Gerace* in view of teachings known to one of ordinary skill in the art.

VII. ARGUMENT

A. Rejection of Claim 32 under 35 U.S.C. §112, second paragraph

Claim 32 added by the Preliminary Amendment filed March 19, 2001 was complete and in compliance with the requirements of 35 U.S.C. §112, second paragraph. A copy of the Preliminary Amendment as downloaded from the Patent Application Information Retrieval (PAIR) system is attached as Appendix D with this language also reflected in Appendix A: Claims Involved in the Appeal. As therein presented, claim 32 reads as follows:

32. *A system for providing a dynamic content window within a windows based content manifestation environment provided within a web browser, comprising:*
a server system configured to transmit a software system and data related to a content source via an electronic data network; and
a web browser client operating within a data processing system that is coupled to said server system via the electronic data network and having a content manifestation environment, said web browser client operative to receive said software system and said data, to process said software system and said data to produce a controllable window object within said content manifestation environment of said web browser client, said controllable window object configured to dynamically manifest therein content received from said content source in accordance with said data.

The Examiner's insistence on relying on any electronic version of the claim is misplaced. Applicant supplied a complete copy of the claim as part of the referenced Preliminary Amendment. While the Examiner maintains that "[c]laim 32 dated 4/2/2004 is chopped off and incomplete" (Final Office Action of 10/04/2006 at page 6, lines, 10-11); Appellant is unaware of any submission corresponding to that date. Further, contrary to the Examiner's assertion, the Response filed 01/05/2006 did include a complete copy of claim 32 at page 4. Since claim 32 was complete in the Preliminary Amendment, there was no need to characterize the language in that Response as constituting an amendment to the claim. Curiously, once Appellant did include the revised language in the listings of the claims as submitted with the Amendment After Final

Action filed 01/04/2007, the Examiner refused entry of the “amendment” without explanation. If the refusal is based on the language of claim 32 raising new issues then it is suggested that such new issues must be based on claim language not before substantively considered. If so, then the rejection of claim 32 under 35 U.S.C. 102(e) as being anticipated by Gerace is likewise improper.

Thus, Appellant respectfully asserts that, for the above reasons, the rejection of claim 32 under 35 U.S.C. §§ 102(e) and 112, second paragraph, are improper and should be overturned.

B. Rejections Under 35 U.S.C. § 102(e) In View of *Gerace*

As more fully set forth below, the rejections under 35 U.S.C. § 102(e) in view of *Gerace* are improper because:

- The complete language of claim 32 was not considered by the Examiner
- The prior art fails to teach every element of the claims in the arrangement specified by the claims.

1. Claims 9, 23, 32, 43 and 54

Claims 9, 23, 32, 43 and 54 (together with dependent claims 10-11, 24-25, 34-38, 45-49 and 56-60, discussed below) stand rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 5,848,396 to Gerace (hereinafter *Gerace*).

Independent claims 9 and 23 each recites, in part "a content manifestation area configured to dynamically manifest advertising content received from an advertising content source via an electronic data network." Appellant's independent claims 32 and 54 each recite, in part, "a web browser client ... operative to receive said software system and said data, to process said software system and data to produce a controllable window object within said content manifestation environment of said web browser client, said controllable window object configured to dynamically manifest therein content received from said content source in accordance with said data." Similarly, Appellant's independent claim 43 recites, in part, a method comprising the step of "dynamically manifesting said content within said controllable window object in accordance with said data."

Referring to column 2, lines 3-30 of *Gerace*, the Examiner asserts that Gerace discloses that the content manifestation area (or controllable window object) is configured to dynamically manifest content, e.g., advertising content, therein. However, column 2, lines 3-30 of *Gerace* merely recites:

The present invention uses agate information to determine the profile of a computer user, and in particular the behavioral or psychographic profile, as distinguished from the demographic profile, of a user. To accomplish this, the

present invention provides (i) a data assembly for displaying customized agate information to a computer user, and (ii) a tracking and profiling member for recording user activity with respect to agate information displayed through the data assembly. Over time, the tracking and profiling member holds a history and/or pattern of user activity which in turn is interpreted as a user's habits and/or preferences. To that end, a psychographic profile is inferred from the recorded activities in the tracking and profiling member.

Further, the tracking and profiling member records presentation (format) preferences of the users based on user viewing activity. Preferences with respect to color schemes, text size, shapes, and the like are recorded as part of the psychographic profile of a user. In turn, the psychographic profile enables the data assembly to customize presentation (format) of agate information, per user, for display to the user.

In the preferred embodiment, the data assembly displays agate information and/or advertisements (combined in a common screen view or separately in respective screen views). The advertisements (stored in an advertisement module, for example) are displayed to users in accordance with the psychographic profile of the user.

As such, *Gerace* merely discloses creating a psychographic profile of a user, and displaying advertising content to the user in accordance with their psychographic profile. Nevertheless, *Gerace* does not disclose or suggest that the content manifestation area dynamically manifests/displays the advertising content to the user, and Appellant respectfully submits that the content manifestation area statically manifests/displays the advertising content to the user. The tracking and profiling member also records demographics of each user. As a result, the data assembly is able to transmit advertisements for display to users based on psychographic and demographic profiles of the user to provide targeted marketing.

In the Examiner's Response to Arguments with regard to Applicant's remarks filed on January 5, 2006, he states that *Gerace* discloses the limitation of claims 9, 23, 32, 43, and 54, which requires dynamic manifestation or dynamic display because he is allowed the broadest possible interpretation of "dynamic." Final Office Action, p. 7. The Examiner quotes from the pending Specification for examples of Applicant's use in the context of the various described embodiments of the claimed invention. The Examiner even quotes to the specific definition of "dynamic manifestation" and "dynamic display" that Applicant recites in the Specification. Final Office Action, p. 7. However, in reaching his conclusions with regard to *Gerace*, the Examiner did not interpret "dynamic manifestation" and "dynamic display" according to the specific definition provided by Applicant.

In construing claim language, the words of a claim "must be given their plain meaning unless applicant has provided a clear definition in the specification." *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). Therefore, the Examiner's attempt to broaden the interpretation of "dynamic" to include the teaching of *Gerace* is improperly ignoring the reasonable interpretation of the claim language. The "dynamic" portion of *Gerace* includes the program controller 79 using the user profiling member 73 to select a particular advertising or screen view to generate and transmit to the user for display. Col. 4, lines 56-64 and Col. 5, lines 15-25. This teaching is not the same as "a content manifestation area configured to dynamically manifest advertising content received from an advertising content source via an electronic data network," as required by claim 9, and similar limitations as disclosed in claims 23, 32, 43, and 54. Therefore, *Gerace* does not teach each and every limitation of claims 9, 23, 32, 43 and 54.

i. Claim 9

As discussed above, independent claim 9 recites, in part "a content manifestation area configured to dynamically manifest advertising content received from an advertising content source via an electronic data network."

In contrast, *Gerace* merely discloses creating a psychographic profile of a user, and displaying advertising content to the user in accordance with their psychographic profile. *Gerace* does not disclose or suggest that the content manifestation area dynamically manifest the

advertising content to the user. Instead, according to *Gerace* the content manifestation area statically manifests/displays the advertising content to the user. As detailed above, in construing claim language, the words of a claim “must be given their plain meaning unless applicant has provided a clear definition in the specification.” *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). Therefore, the Examiner’s attempt to broaden the interpretation of “dynamic” to include the teaching of *Gerace* improperly ignores the reasonable interpretation of the claim language. The “dynamic” portion of *Gerace* includes the program controller 79 using the user profiling member 73 to select a particular advertising or screen view to generate and transmit to the user for display. Col. 4, lines 56-64 and Col. 5, lines 15-25. This teaching is not the same as “a content manifestation area configured to dynamically manifest advertising content received from an advertising content source via an electronic data network,” as required by claim 9.

For the reasons presented the rejection of claim 9 is believed to be improper.

ii. Claim 23

As discussed above, independent claim 23 recites, in part "a content manifestation area configured to dynamically manifest advertising content received from an advertising content source via an electronic data network", as does claim 9, further including “a control facility configured to control display attributes associated with said content manifestation area.”

As detailed in connection with claim 9, *Gerace* merely discloses creating a psychographic profile of a user, and displaying advertising content to the user in accordance with their psychographic profile. *Gerace* does not disclose or suggest that the content manifestation area dynamically manifest the advertising content to the user. Instead, according to *Gerace* the content manifestation area statically manifests/displays the advertising content to the user. As detailed above, in construing claim language, the words of a claim “must be given their plain meaning unless applicant has provided a clear definition in the specification.” *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). Therefore, the Examiner’s attempt to broaden the interpretation of “dynamic” to include the teaching of *Gerace* improperly ignores the reasonable interpretation of the claim language. The “dynamic” portion of *Gerace* includes the program controller 79 using the user profiling member 73 to select a particular advertising or screen view to generate and transmit to the user for display. Col. 4, lines 56-64 and Col. 5, lines 15-25. This teaching is

not the same as “a content manifestation area configured to dynamically manifest advertising content received from an advertising content source via an electronic data network,” and further including “a control facility configured to control display attributes associated with said content manifestation area” as required by claim 23.

For the reasons presented the rejection of claim 23 is believed to be improper.

iii. Claim 32

The rejection of claim 32 under 35 U.S.C. 102(e) are improper for the reasons present *supra*. In particular, the Examiner has acknowledged that he has not considered all of the language of the claim in applying the art while the asserted rejection is additionally defective for the reasons presented in connection with claims 9 and 23.

The Examiner takes the position that claim 32 is incomplete. It is not clear what language the Examiner contends is missing. However, in determining the patentability of a claim the Examiner must consider all of the claim language and explain how the prior art applies to that claim language. By the Examiner’s own admission, not all of the language of claim 32 was considered, even though the complete claim was presented in the Preliminary Amendment filed March 19, 2001 and attached hereto as Appendix D. Accordingly, the rejection is improper for failure of the Examiner to consider the entire claim as presented and apply the art thereto.

Claim 32 is additionally considered to patentable for the reasons presented *supra* and repeated herein. In particular, claim 32 recites, in part, "a web browser client ... operative to receive said software system and said data, to process said software system and data to produce a controllable window object within said content manifestation environment of said web browser client, said controllable window object configured to dynamically manifest therein content received from said content source in accordance with said data."

In contrast, *Gerace* merely discloses creating a psychographic profile of a user, and displaying advertising content to the user in accordance with their psychographic profile. *Gerace* does not disclose or suggest that the content manifestation area dynamically manifests/displays the advertising content to the user, and Appellant

respectfully submits that the content manifestation area statically manifests/displays the advertising content to the user. The tracking and profiling member also records demographics of each user. As a result, the data assembly is able to transmit advertisements for display to users based on psychographic and demographic profiles of the user to provide targeted marketing.

While the Examiner takes the position that he is allowed the broadest possible interpretation of dynamically manifesting content, it is clear that such interpretation is limited by the plain meaning that would be given that terminology by one skilled in the art. That is, in reaching his conclusions with regard to *Gerace*, the Examiner did not interpret “dynamic manifestation”(and/or “dynamic display”) according to the plain meaning of the terminology. In construing claim language, the words of a claim “must be given their plain meaning unless applicant has provided a clear definition in the specification.” *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). Therefore, the Examiner’s attempt to broaden the interpretation of “dynamic” to include the teaching of *Gerace* is improperly ignores the reasonable interpretation of the claim language.

For the reasons presented, the rejection of claim 32 under 35 U.S.C. 102(e) is improper.

iv. Claim 43

Appellant’s independent claim 43 recites, in part, a method comprising the step of "dynamically manifesting said content within said controllable window object in accordance with said data." For the reasons presented *supra* and repeated herein, the rejection is believe to be improper, the Examiner failing to attribute the plain meaning of the phrase “dynamically manifesting”.

Referring to column 2, lines 3-30 of *Gerace*, the Examiner asserts that *Gerace* discloses that the content manifestation area (or controllable window object) is configured to dynamically manifest content, e.g., advertising content, therein. However, as detailed above, *Gerace* merely discloses creating a psychographic profile of a user, and displaying advertising content to the user in accordance with their psychographic profile. *Gerace* does not disclose or suggest that the content manifestation area

dynamically manifests/displays the advertising content to the user; Appellant respectfully again submits that the content manifestation area of *Gerace* statically manifests/displays the advertising content to the user. That is, according to *Gerace* the tracking and profiling member records demographics of each user. As a result, the data assembly is able to transmit advertisements for display to users based on psychographic and demographic profiles of the user to provide targeted marketing. However, this is different from the claimed step of “dynamically manifesting said content within said controllable window object in accordance with said data.”

As in the rejections of the other independent claims, the Examiner improperly applies the broadest possible interpretation of “dynamic.” In construing claim language, the words of a claim “must be given their plain meaning unless applicant has provided a clear definition in the specification.” *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). Therefore, the Examiner’s attempt to broaden the interpretation of “dynamic” to include the teaching of *Gerace* is improperly ignoring the reasonable interpretation of the claim language. The “dynamic” portion of *Gerace* includes the program controller 79 using the user profiling member 73 to select a particular advertising or screen view to generate and transmit to the user for display. Col. 4, lines 56-64 and Col. 5, lines 15-25. This teaching is not the same as “dynamically manifesting said content within said controllable window object in accordance with said data” as required by claim 43. Therefore, *Gerace* does not teach each and every limitation of claim 43.

For the reasons presented, the rejection of claim 43 is believed to be improper.

v. Claim 54

Appellant’s independent claim 54 recites, in part, “a web browser client ... operative to receive said software system and said data, to process said software system and data to produce a controllable window object within said content manifestation environment of said web browser client, said controllable window object configured to dynamically manifest therein content received from said content source in accordance with said data.” When properly interpreted, there limitations patentably distinguish the invention of claim 54 over *Gerace* for the reasons presented supra and repeated herein.

As previously argued, the Examiner asserts that Gerace discloses that the content manifestation area (or controllable window object) is configured to dynamically manifest content, e.g., advertising content, therein. However, column 2, lines 3-30 of *Gerace* merely recites creating a psychographic profile of a user, and displaying advertising content to the user in accordance with their psychographic profile. *Gerace* does not disclose or suggest that the content manifestation area dynamically manifests/displays the advertising content to the user.

Contrary to the Examiner's position, the claimed dynamic manifestation language should be given its plain meaning, not the broadest possible interpretation. In reaching his conclusions with regard to *Gerace*, the Examiner improperly fails to apply the plain meaning of "dynamic manifestation" in formulating the outstanding rejections.

For the reasons presented, the rejection of claim 54 is considered to be improper.

2. Dependent Claims 10, 24 and 48 are Separately Patentable

Dependent claims 10, and 24 require the content manifestation area be configured to dynamically receive content from at least one advertising content source:

...wherein said content manifestation area is configured to dynamically receive content from at least one advertising content source.

Dependent claim 48 requires that the web browser client access the content source in accordance with the data to receive content to be dynamically manifested within the controllable window object. As detailed above, *Gerace* fails to describe or suggest that the content manifestation area dynamically manifests/displays the advertising content to the user. Thus, Appellant respectfully asserts that, for the above reasons, claims 10, 24 and 48 are patentable over the 35 U.S.C. § 102(e) rejection of record.

3. Dependent Claims 11, 25, 38, 49 and 60 are Separately Patentable

Claims 11 and 25 require that the content manifestation area be configured to continuously receive and manifest a content stream. Claims 38, 49 and 60 require that the web browser client accesses the content source more than one time to receive corresponding different content to be dynamically manifested within the controllable window object. As set forth above,

Gerace describes static, not dynamic manifestation of content and thereby fails to anticipate the subject matter of claims 25, 38, 49 and 60. Thus, Appellant respectfully asserts that, for the above reasons, claims 25, 38, 49 and 60 are patentable over the 35 U.S.C. § 102(e) rejection of record.

4. Dependent Claims 34-37, 45-47 and 56-59 are Separately Patentable

Dependent claims 34, 45 and 56 require that the content source includes full motion video content.

Dependent claims 35, 46 and 57 require that the content source includes an audio feed.

Dependent claims 36, 47 and 58 require that the electronic data network be the Internet.

Dependent claims 37 and 59 require that the web browser client access the content source via the Internet to receive content to be dynamically manifested within the controllable window object.

Each of these claims is dependent from one of claims 32, 43 or 56 and thereby includes the limitations described therein. As such, the rejected claims require that the content manifestation area (or controllable window object) be configured to dynamically manifest content, e.g., advertising content, therein. As *Gerace* fails to teach or suggest dynamic manifestation when this term is properly construed as urged above, the corresponding rejection of claims 34-37, 45-47 and 56-59 is similarly defective.

C. Rejections Under 35 U.S.C. §103(a) As Being Unpatentable Over *Gerace* In View Of Teachings Known To One Of Ordinary Skill In The Art

Claims 12, 13, 26-31, 33, 39-42, 44, 50-53, 55, and 61-64 each depend from one of the independent claims 9, 23, 32, 43, and 54. "If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious." MPEP 2143.03 (citations omitted).

As noted above, *Gerace* fails to teach the dynamic manifestation and dynamic display as required in claims 9, 23, 32, 43, and 54. The Examiner does not offer obviousness to cure this deficiency nor has the Examiner offered any additional references which he alleges teach such a limitation. Therefore, *Gerace* does not teach or even suggest each and every limitation of claims 12, 13, 26-31, 33, 39-42, 44, 50-53, 55, and 61-64.

1. Claims 12 and 26

Claims 12 and 26 require that the content manifestation area be moveable and draggable within a content manifestation environment provided by a WWW browser. As previously discussed, the content manifestation area is configured to dynamically manifest advertising content, something that *Gerace* fails to describe or suggest when properly interpreted as set forth above. Accordingly, the rejection of claims 12 and 26 under 35 U.S.C. §103(a) is believed to be improper.

2. Claims 13, 27-31, 33, 39-42, 44, 50-53, 55 and 61-64

i. Claims 13 and 27

Claims 13 and 27 require that the content manifestation area correspond to a section of a screen within a content manifestation environment provided by a WWW browser. As previously discussed, the content manifestation area is configured to dynamically manifest advertising content, something that *Gerace* fails to describe or suggest when properly interpreted as set forth above. Accordingly, the rejection of claims 13 and 27 under 35 U.S.C. §103(a) is believed to be improper.

ii. Claims 28, 40, 51 and 62

Claims 28, 40, 51 and 62 require that the control facility permit the content manifestation area to be maximized.. As previously discussed, the content manifestation area is configured to dynamically manifest advertising content, something that *Gerace* fails to describe or suggest when properly interpreted as set forth above. Accordingly, the rejection of claims 28, 40, 51 and 62 under 35 U.S.C. §103(a) is believed to be improper.

iii. Claims 29, 39, 50 and 61

Claims 29, 39, 50 and 61 require that the control facility permit the content manifestation area to be minimized. As previously discussed, the content manifestation area is configured to dynamically manifest advertising content, something that *Gerace* fails to describe or suggest when properly interpreted as set forth above. Accordingly, the rejection of claims 29, 39, 50 and 61 under 35 U.S.C. §103(a) is believed to be improper.

iv. Claims 30, 41, 52 and 63

Claims 30, 41, 52 and 63 require that the control facility permit the content manifestation area to be re-sized. As previously discussed, the content manifestation area is configured to dynamically manifest advertising content, something that *Gerace* fails to describe or suggest when properly interpreted as set forth above. Accordingly, the rejection of claims 30, 41, 52 and 63 under 35 U.S.C. §103(a) is believed to be improper.

v. Claims 31, 42, 53 and 64

Claims 31, 42, 53 and 64 require that the control facility permits the content manifestation area to be closed.. As previously discussed, the content manifestation area is configured to dynamically manifest advertising content, something that *Gerace* fails to describe or suggest when properly interpreted as set forth above. Accordingly, the rejection of claims 31, 42, 53 and 64 under 35 U.S.C. §103(a) is believed to be improper.

vi. Claims 33, 44 and 55

Claims 33, 44 and 55 require that the software system includes instructions related to the

size and placement of the controllable window object within said content manifestation environment. As previously discussed, the content manifestation area is configured to dynamically manifest advertising content, something that *Gerace* fails to describe or suggest when properly interpreted as set forth above. Accordingly, the rejection of claims 33, 44 and 55 under 35 U.S.C. §103(a) is believed to be improper.

D. Conclusion

Appellant has provided arguments that overcome the pending rejections. The Examiner's conclusion that the claims should be rejected is unwarranted. Therefore, Appellant respectfully requests that the Board overturn the Examiner's rejection of claims 9-13 and 23-64.

A copy of the claims involved in the present appeal is attached hereto as Appendix A.

This Appeal Brief is accompanied by payment of the fee for filing a brief in support of an appeal under 41.20(b)(2) together with a petition and corresponding fee for a five month extension of time. If any additional fees are due in connection with this filing, please charge our Deposit Account No. 06-2375, under Order No. P007C1/10613699 from which the undersigned is authorized to draw and please credit any excess fees to such deposit account.

Dated: January 14, 2008

Respectfully submitted,

By /Michael J. Strauss/
Michael J. Strauss
Registration No.: 32,443
FULBRIGHT & JAWORSKI L.L.P.
801 Pennsylvania Avenue, N.W.
Washington, DC 20004-2623
(202) 662-0200
(202) 662-4643 (Fax)
Attorney for Applicant / Appellant

APPENDIX A

Claims Involved in the Appeal of Application Serial No. 10/672,945

9. A window object manifested within a windows based content manifestation environment provided within a web browser client, comprising:

a content manifestation area configured to dynamically manifest advertising content received from an advertising content source via an electronic data network.

10. The window object according to claim 9, wherein said content manifestation area is configured to dynamically receive content from at least one advertising content source.

11. The window object according to claim 9, wherein said content manifestation area is configured to continuously receive and manifest a content stream.

12. The window object according to claim 9, wherein said content manifestation area is moveable and draggable within a content manifestation environment provided by a WWW browser.

13. The window object according to claim 9, wherein said content manifestation area corresponds to a section of a screen within a content manifestation environment provided by a WWW browser.

23. A controllable window object manifested within a content manifestation environment provided within a web browser client, comprising:

a content manifestation area configured to dynamically manifest advertising content received from an advertising content source via an electronic data network; and

a control facility configured to control display attributes associated with said content manifestation area.

24. The controllable window object according to claim 23, wherein said content manifestation area is configured to dynamically receive content from at least one advertising content source.

25. The controllable window object according to claim 23, wherein said content manifestation area is configured to continuously receive and manifest a content stream.

26. The controllable window object according to claim 23, wherein said content manifestation area is moveable within a content manifestation environment provided by said WWW browser client.

27. The controllable window object according to claim 23, wherein said content manifestation area corresponds to a section of a screen within a content manifestation environment provided by a WWW browser client.

28. The controllable window object according to claim 23, wherein said control facility permits said content manifestation area to be maximized.

29. The controllable window object according to claim 23, said control facility permits said content manifestation area to be minimized.

30. The controllable window object according to claim 23, wherein said control facility permits said content manifestation area to be re-sized.

31. The controllable window object according to claim 23, wherein said control facility permits said content manifestation area to be closed.

32. A system for providing a dynamic content window within a windows based content manifestation environment provided within a web browser, comprising:

a server system configured to transmit a software system and data related to a content source via an electronic data network; and

a web browser client operating within a data processing system that is coupled to said server system via the electronic data network and having a content manifestation environment, said web browser client operative to receive said software system and said data, to process said software system and said data to produce a controllable window object within said content manifestation environment of said web browser client, said controllable window object configured to dynamically manifest therein content received from said content source in accordance with said data.

33. The system according to claim 32, wherein said software system includes instructions related to the size and placement of said controllable window object within said content manifestation environment.

34. The system according to claim 32, wherein said content source includes full motion video content.

35. The system according to claim 32, wherein said content source includes an audio feed.

36. The system according to claim 32, wherein said electronic data network is the Internet.

37. The system according to claim 36, wherein said web browser client accesses said content source via the Internet to receive content to be dynamically manifested within said controllable window object.

38. The system according to claim 32, wherein said web browser client accesses said content source more than one time to receive corresponding different content to be dynamically manifested within said controllable window object.

39. The system according to claim 32, wherein said controllable window object further includes a control facility that permits said controllable window object to be minimized.

40. The system according to claim 32, wherein said controllable window object further includes a control facility that permits said controllable window object to be maximized.

41. The system according to claim 32, wherein said controllable window object further includes a control facility that permits said controllable window object to be re-sized.

42. The system according to claim 32, wherein said controllable window object further includes a control facility that permits said controllable window object to be closed thereby preventing dynamic manifestation of said content within said controllable window object.

43. A method for providing a controllable window object within a windows Lased content manifestation environment provided within a web browser, comprising the following steps:

from a server system, transmitting a software system and data related to a content source via an electronic data network;

at a web browser client operating within a data processing system that is coupled to said server system via the electronic data network, receiving said software system;

processing said software system and said data to produce a controllable window object within a content manifestation environment provided by said web browser; and

dynamically manifesting said content within said controllable window object in accordance with said data.

44. The method according to claim 39, wherein said software system includes instructions related to the size and placement of said controllable window object within said content manifestation environment.

45. The method according to claim 43, wherein said data relates to a full motion video content source.

46. The method according to claim 43, wherein said data relates to an audio feed.

47. The method according to claim 43, wherein said electronic data network is the Internet.

48. The method according to claim 43, wherein said web browser client accesses said content source in accordance with said data to receive content to be dynamically manifested within said controllable window object.

49. The method according to claim 43, wherein said web browser client accesses said content source in accordance with said data more than one time to receive corresponding different content to be dynamically manifested within said controllable window object.

50. The method according to claim 43, further comprising the step of providing a control facility to correspond to said controllable window object, said control facility permitting said controllable window object to be minimized.

51. The method according to claim 43, further comprising the step of providing a control facility to correspond to said controllable window object, said control facility permitting said controllable window object to be maximized.

52. The method according to claim 43, further comprising the step of providing a control facility to correspond to said controllable window object, said control facility permitting said controllable window object to be re-sized.

53. The method according to claim 43, further comprising the step of providing a control facility to correspond to said controllable window object, said control facility permitting said controllable window object to be closed.

54. A system for providing a dynamic content window within a windows based content manifestation environment provided within a web browser, comprising:

a server system configured to transmit a software system and data related to a content source via an electronic data network; and

a web browser client operating within a data processing system that is coupled to said server system via the electronic data network and having a content manifestation environment, said web browser client operative to receive said software system and said data, to process said software system and said data to produce a window object within said content manifestation environment of said web browser client, said window object configured to dynamically manifest therein content received from said content source in accordance with said data, said window object being under the direct control of the web browser.

55. The system according to claim 54, wherein said software system includes instructions related to the size and placement of said controllable window object within said content manifestation environment.

56. The system according to claim 54, wherein said content source includes fill motion video content.

57. The system according to claim 54, wherein said content source includes an audio feed.

58. The system according to claim 54, wherein said electronic data network is the Internet.

59. The system according to claim 58, wherein said web browser client accesses said content source via the Internet to receive content to be dynamically manifested within said controllable window object.

60. The system according to claim 54, wherein said web browser client accesses said content source more than one time to receive corresponding different content to be dynamically manifested within said controllable window object.

61. The system according to claim 54, wherein said controllable window object further includes a control facility that permits said controllable window object to be minimized.

62. The system according to claim 54, wherein said controllable window object further includes a control facility that permits said controllable window object to be maximized.

63. The system according to claim 54, wherein said controllable window object further includes a control facility that permits said controllable window object to be re-sized.

64. The system according to claim 54, wherein said controllable window object further includes a control facility that permits said controllable window object to be closed thereby preventing dynamic manifestation of said content within said controllable window object client.

APPENDIX B

EVIDENCE

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

APPENDIX C

RELATED PROCEEDINGS

There being no final decisions rendered by the Court in connection with the proceeding referenced in section II, none are attached.

APPENDIX D

COPY OF PRELIMINARY AMENDMENT

A copy of the Preliminary Amendment filed March 19, 2001 including claim 32 follows.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of:
SANDRO PASQUALI

Attorney's Docket No.:
040.0058

Filed:
March 20, 2001

Serial No.:
Unassigned

For: **SYSTEM AND METHOD FOR PROVIDING
A DYNAMIC ADVERTISING CONTENT
WINDOW WITHIN A WINDOW BASED
CONTENT MANIFESTATION
ENVIRONMENT PROVIDED IN A
BROWSER**

Group No.:
Unassigned

Examiner:
Unassigned

PRELIMINARY AMENDMENT

Assistant Commissioner for Patents
United States Patent and Trademark Office
Washington, DC 20231

S I R:

Prior to or contemporaneous with the review and examination of the above-identified U.S. patent application, please enter the following Amendments and Remarks. This U.S. patent application is a continuation application under 37 C.F.R. § 1.53(b) of U.S. Patent Application Serial No. 09/252,076, filed on February 18, 1999, which application is now pending before the USPTO.

Please process the following Amendments:

IN THE SPECIFICATION:

On page 1 of the application, after the TITLE OF THE INVENTION section and at line 6, please **INSERT** the following new section:

--RELATED APPLICATION DATA

This application is a Continuation of U.S. Patent Application Serial No. 09/252,076, filed on February 18, 1999, which application is now pending before the USPTO. --

IN THE CLAIMS:

Please **CANCEL** claims 1-8 and 14-22 without prejudice to the subject matter defined therein. Claims 1-8 and 14-22 have been allowed in Applicant's co-pending U.S. Patent Application No. 09/252,076.

Please **ADD** the following claims:

23. (Newly Added) A controllable window object manifested within a content manifestation environment provided within a web browser client, comprising:
- a content manifestation area configured to dynamically manifest advertising content received from an advertising content source via an electronic data network; and
 - a control facility configured to control display attributes associated with said content manifestation area.
24. (Newly Added) The controllable window object according to claim 23, wherein said content manifestation area is configured to dynamically receive content from at least one advertising content source.
25. (Newly Added) The controllable window object according to claim 23, wherein said content manifestation area is configured to continuously receive and manifest a content stream.

26. (Newly Added) The controllable window object according to claim 23, wherein said content manifestation area is moveable within a content manifestation environment provided by said WWW browser client.

27. (Newly Added) The controllable window object according to claim 23, wherein said content manifestation area corresponds to a section of a screen within a content manifestation environment provided by a WWW browser client.

28. (Newly Added) The controllable window object according to claim 23, wherein said control facility permits said content manifestation area to be maximized.

29. (Newly Added) The controllable window object according to claim 23, wherein said control facility permits said content manifestation area to be minimized.

30. (Newly Added) The controllable window object according to claim 23, wherein said control facility permits said content manifestation area to be re-sized.

31. (Newly Added) The controllable window object according to claim 23, wherein said control facility permits said content manifestation area to be closed.

32. (Newly Added) A system for providing a dynamic content window within a windows based content manifestation environment provided within a web browser, comprising:

a server system configured to transmit a software system and data related to a content source via an electronic data network; and

a web browser client operating within a data processing system that is coupled to said server system via the electronic data network and having a content manifestation

environment, said web browser client operative to receive said software system and said data, to process said software system and said data to produce a controllable window object within said content manifestation environment of said web browser client, said controllable window object configured to dynamically manifest therein content received from said content source in accordance with said data.

33. (Newly Added) The system according to claim 32, wherein said software system includes instructions related to the size and placement of said controllable window object within said content manifestation environment.

34. (Newly Added) The system according to claim 32, wherein said content source includes full motion video content.

35. (Newly Added) The system according to claim 32, wherein said content source includes an audio feed.

36. (Newly Added) The system according to claim 32, wherein said electronic data network is the Internet.

37. (Newly Added) The system according to claim 36, wherein said web browser client accesses said content source via the Internet to receive content to be dynamically manifested within said controllable window object.

38. (Newly Added) The system according to claim 32, wherein said web browser client accesses said content source more than one time to receive corresponding different content to be dynamically manifested within said controllable window object.

39. (Newly Added) The system according to claim 32, wherein said controllable window object further includes a control facility that permits said controllable window object to be minimized.

40. (Newly Added) The system according to claim 32, wherein said controllable window object further includes a control facility that permits said controllable window object to be maximized.

41. (Newly Added) The system according to claim 32, wherein said controllable window object further includes a control facility that permits said controllable window object to be re-sized.

42. (Newly Added) The system according to claim 32, wherein said controllable window object further includes a control facility that permits said controllable window object to be closed thereby preventing dynamic manifestation of said content within said controllable window object.

43. (Newly Added) A method for providing a controllable window object within a windows based content manifestation environment provided within a web browser, comprising the following steps:

from a server system, transmitting a software system and data related to a content source via an electronic data network;

at a web browser client operating within a data processing system that is coupled to said server system via the electronic data network, receiving said software system;

processing said software system and said data to produce a controllable window object within a content manifestation environment provided by said web browser; and

dynamically manifesting said content within said controllable window object in accordance with said data.

44. (Newly Added) The method according to claim 39, wherein said software system includes instructions related to the size and placement of said controllable window object within said content manifestation environment.

45. (Newly Added) The method according to claim 43, wherein said data relates to a full motion video content source.

46. (Newly Added) The method according to claim 43, wherein said data relates to an audio feed.

47. (Newly Added) The method according to claim 43, wherein said electronic data network is the Internet.

48. (Newly Added) The method according to claim 43, wherein said web browser client accesses said content source in accordance with said data to receive content to be dynamically manifested within said controllable window object.

49. (Newly Added) The method according to claim 43, wherein said web browser client accesses said content source in accordance with said data more than one time to receive corresponding different content to be dynamically manifested within said controllable window object.

50. (Newly Added) The method according to claim 43, further comprising the step of providing a control facility to correspond to said controllable window object, said control facility permitting said controllable window object to be minimized.

51. (Newly Added) The method according to claim 43, further comprising the step of providing a control facility to correspond to said controllable window object, said control facility permitting said controllable window object to be maximized.

52. (Newly Added) The method according to claim 43, further comprising the step of providing a control facility to correspond to said controllable window object, said control facility permitting said controllable window object to be re-sized.

53. (Newly Added) The method according to claim 43, further comprising the step of providing a control facility to correspond to said controllable window object, said control facility permitting said controllable window object to be closed.

54. (Newly Added) A system for providing a dynamic content window within a windows based content manifestation environment provided within a web browser, comprising:

a server system configured to transmit a software system and data related to a content source via an electronic data network; and

a web browser client operating within a data processing system that is coupled to said server system via the electronic data network and having a content manifestation environment, said web browser client operative to receive said software system and said data, to process said software system and said data to produce a window object within said content manifestation environment of said web browser client, said window object

configured to dynamically manifest therein content received from said content source in accordance with said data, said window object being under the direct control of the web browser

55. (Newly Added) The system according to claim 54, wherein said software system includes instructions related to the size and placement of said controllable window object within said content manifestation environment.

56. (Newly Added) The system according to claim 54, wherein said content source includes full motion video content.

57. (Newly Added) The system according to claim 54, wherein said content source includes an audio feed.

58. (Newly Added) The system according to claim 54, wherein said electronic data network is the Internet.

59. (Newly Added) The system according to claim 58, wherein said web browser client accesses said content source via the Internet to receive content to be dynamically manifested within said controllable window object.

60. (Newly Added) The system according to claim 54, wherein said web browser client accesses said content source more than one time to receive corresponding different content to be dynamically manifested within said controllable window object.

61. (Newly Added) The system according to claim 54, wherein said controllable window object further includes a control facility that permits said controllable window object to be minimized.

62. (Newly Added) The system according to claim 54, wherein said controllable window object further includes a control facility that permits said controllable window object to be maximized.

63. (Newly Added) The system according to claim 54, wherein said controllable window object further includes a control facility that permits said controllable window object to be re-sized.

64. (Newly Added) The system according to claim 54, wherein said controllable window object further includes a control facility that permits said controllable window object to be closed thereby preventing dynamic manifestation of said content within said controllable window object. client.

REMARKS

Prior to or contemporaneous with the review and examination of the instant U.S. patent application, please enter this Preliminary Amendment into the official files of the instant and newly filed U.S. Patent Application, and process the amendments contained herein. This U.S. patent application is a continuation application under 37 C.F.R. § 1.53(b) of U.S. Patent Application Serial No. 09/252,076, filed on February 18, 1999, which application is now pending before the USPTO.

Claims 1-8 and 14-22 have been allowed in Applicant's co-pending U.S. Patent Application Serial No. 09/252,076. In the instant patent application, claims 9-13 and

claims 23 through 64 which have been added by way of this Preliminary Amendment are pending and are presented for examination on their merits, which action is earnestly solicited.

CONCLUSION:

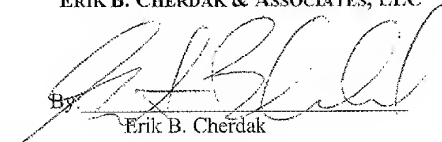
Claims 9-13 and claims 23 through 64 which have been added by way of this Preliminary Amendment are pending and are presented for examination on their merits, which action is earnestly solicited.

If the Examiner believes that an in-person or telephonic interview will in any way expedite the prosecution of the instant U.S. patent application, the Examiner is invited to contact the undersigned attorney of record at the address and telephone numbers listed below.

It is believed that fees are due in regard to the submission of this Preliminary Amendment. Such fees have been paid in the form of a check in the amount of \$676.00. If additional fees are deemed due and/or owing, the USPTO is invited to contact the undersigned attorney of record at the address and telephone numbers listed below.

Respectfully submitted,

ERIK B. CHERDAK & ASSOCIATES, LLC

By: 
Erik B. Cherdak
Reg. No. 39,936

11300 Rockville Pike, Suite 906
Rockville, Maryland 20852
(301) 984-4700
Fax (301) 984-9676
Date: 5/26/2001